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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/569,519

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Roman Stauch

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34704 7590 03/20/2008

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EXAMINER

WISTERMAYER, ALEXIS M

ART UNIT

PAPER NUMBER

3733

MAIL DATE

DELIVERY MODE

03/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/569,519	<b>Applicant(s)</b> STAUCH, ROMAN	
	<b>Examiner</b> Alexis M. Wistermayer	<b>Art Unit</b> 3733	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 1-11 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 12-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 February 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |                                                                                      |                                                                   |
|--------------------------------------------------------------------------------------|-------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____                                                          | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 14 recites the limitation "wherein the drive element" in lines 1 and 2. There is insufficient antecedent basis for this limitation in the claim.

Claims 12-20 are objected to because of the following informalities: Claims are misnumbered. Appropriate correction is required.

The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 12-20 been renumbered 11-19.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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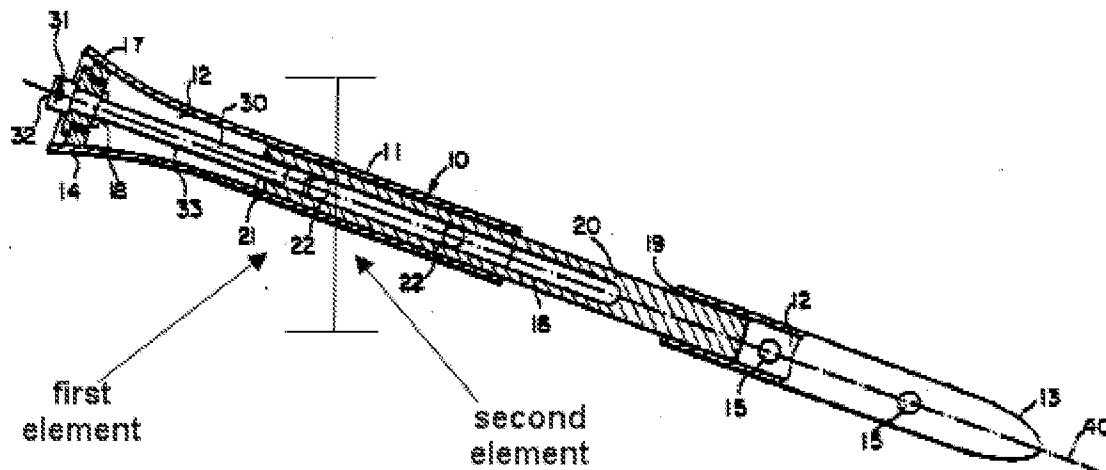
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 11, 12, and 15 -17 are rejected under 35 U.S.C. 102(b) as being anticipated by Baumgart et al (US Pat 5263955).

Baumgart et al. disclose a device comprising a first element and second element (please see the drawing below as depicted from the patent cover page's illustration), an electric motor associated with the first element (Col 2 Lines 10-35), a drive shaft (Col 2 Lines 1-5, in that the drive for longitudinal displacement is interpreted as having a drive shaft), guide means located on the first element (area indicated by 10 in Fig 3) so that the first element and second element move axially relative to one another without radial torsion (Col 1 Lines 10-20), said guide means comprising an inner surface an inner surface on the first element having a polygonal shape, namely a circle (Fig 3), an inner cross section of the second element configured as a cylindrical bore provided with an inner circumferential surface having a thread (Col 3 Lines 20-40) a radial locking bore provided in the first and second elements (22 and 15, respectively, in Fig 4), and at least one sealing element inserted between the first and second elements (16).

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### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgart et al. in view of Betz et al. (US Pat 6245075).

Baumgart et al. disclose the above claimed invention except for a planetary roller system and a sensor means connected with an electronics unit.

Betz et al. disclose a distraction device for extending bones comprising planetary rollers (Fig 1 Elements 19) and a sensor means connected with a telemetry system (Col 3 Lines 5-10). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the planetary rollers and sensor means of Betz et al. in Baumgart et al.'s device to offer an alternative means of accurately extending the length of a patient's bone.

Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgart et al. in view of Betz et al. as applied to claim 18 above, and further in view of Er et al (US Pat 610415).

Baumgart et al. and Betz et al. disclose the claimed invention except for a data transmission unit.

Er et al. disclose an implantable medical device comprising a data transmitter unit (130 in Fig 4a). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use the data transmitter unit of Er et al. in the combination of Baumgart et al.'s and Betz et al.'s device to offer an equivalent means of transmitting data from the device to an external source in the OR.

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baumgart et al. in view of Li (US PGPub 2003/0204190).

Baumgart et al. disclose the claimed invention except for a device wherein the second element engages as an outer sleeve over the first element and receives the first element inside it.

Li discloses a bone expanding device wherein the second element receives the first element inside of it (14 and 16 in Figs 3 and 4, respectively). ). It would have been obvious to one having ordinary skill in the art at the time the invention was made to use Li's first and second elements in Baumgart et al.'s device to offer an equivalent means of extending the bones.

### ***Conclusion***

The prior art made of record and relied upon is considered pertinent to the applicant's disclosure. See PTO-892 for art cited of interest.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alexis M. Wistermayer whose telephone number is 571-270-3304. The examiner can normally be reached on Monday - Friday 8 am - 4 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on 571-272-4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/A. M. W./  
Examiner, Art Unit 3733

/Eduardo C. Robert/  
Supervisory Patent Examiner, Art Unit 3733